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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,196	11/30/2001	Osmo Suovaniemi	0933-0177P	9571

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EXAMINER

GORDON, BRIAN R

ART UNIT	PAPER NUMBER
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1743

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DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/980,196

Examiner

Brian R. Gordon

Applicant(s)

SUOVANIEMI ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. PCT/FI00/00544, filed on June 16, 2000.

Specification

2. The disclosure is objected to because of the following informalities: on page 5, line 2 "hte" is a misspelled word.

Appropriate correction is required.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "telescopic extension of the plunger" and "the body" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-7 are intended to be method claims as indicated by the preamble, however the claims are drafted in a form in which specific steps are disclosed to perform a method. The claim appears to be moreso directed to the structure used in applicant's method. It is suggested that applicant clearly point out what steps are included in the desired method by clearly establishing the end of the preamble. For example after the required structure (claims 1 and 4) is defined in the claim, applicant can state...."the method comprising the steps of:..."

As to claims 1, 3, 4, 6, and 8, the term "disposable" does not add any structure to the device. The term is a relative term for it is the decision of the user to dispose of a tip as so desired. It is suggested that the term be replaced with a term such as "removable" or "detachable".

Claims 1 and 4, recite the phrase "...a barrier means to close an opening...", the term "to" should be "for". The examiner asserts that this phrase is somewhat contradictory of applicant's teachings. The term "close" does not adequately describe the function of the "barrier means". As taught by the specification on page 4 liens 23-24, the barrier means is impermeable to liquids and permeable to gases. As such the barrier means does not fully close the opening for it allows for gases to pass through.

Claims 1, 4, and 8, recite the phrase ".....for receiving a sample to the tip and removing it therefrom,.." it is unclear what "it" refers to, however, the examiner believes

applicant is referring to "the tip" and therefore it is suggested that the term pronoun "it" be replaced with the specific element (the tip).

For the purpose of examination, the examiner has interpreted the method of claim 1 (requiring the structure of the mechanical pipette) as a process in which in general the plunger is moved in a direction towards the barrier means in order to remove the barrier means from the end part of the suction device.

As to claim 8, it is unclear what elements applicant intends to claim as elements of the device. The phrase "...the body for removably attaching a disposable tip.." is a recitation that does not positively recite the tip as an element of the invention. The tip is mentioned in an intended use phrase of the end part.

The phrase "...at least one position in which the plunger can be brought into contact with the barrier means adapted to the end part...." is mentioned within a phrase that does not positively recite the barrier means as an element of the invention. The phrase mentions the intended use of the plunger.

As to claims 1, 4, and 8, it is unclear what is the difference between "the body" and "the end part". Are they two distinct elements or is the end part an element of the body? The claims recite that the tip is attached to the body, however the specification and drawings disclose the tip as being attached to the end part.

6. Claim 2 recites the limitation "the means for limiting movement of the plunger" in line 2. There is insufficient antecedent basis for this limitation in the claim.
7. Claim 8 recites the limitation "the barrier means" in third from last line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 8-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 19 (including the limitations of base claim 1) of U.S. Patent No. 6,482,361 in view of Magnussen, Jr. et al. US 5,364,596. Claim 19 of US Patent No. 6,482,361 includes all the limitations of claims 8-10 of the instant applications with the exception of the "means which limit the movement of the plunger..." and the suction device being multichannel.

Magnussen Jr. et al. disclose a manual pipette including user controllable latch and trigger mechanisms for releasably locking the plunger of the pipette in a "home" position ready for immersion of the pipette tip in a fluid to be drawn into the tip and further including a user controllable velocity governor for regulating the rate of plunger return from the "home" position to a first or upper stop position in drawing the fluid into the tip.

Magnussen Jr. et al. Further teaches that most commercially available multi-channel manual pipettes function in substantially the same manner as the single channel manual pipettes except that they contain multiple liquid ends each having a separate piston driven in unison from a common spring biased plunger unit. Other commercially available multi-channel manual pipettes such as the Costar Octapette and 12-Pette multichannel pipettes comprise a pistol grip structure for hand gripping by a user with his forefinger extending forward to engage and wrap partially around a spring biased actuator. In both types of multi-channel manual pipettes, the "home" position for the plunger unit is defined by a "soft" stop as in the previously described single channel manual pipettes and a steady force on the actuator is required to maintain the plunger unit at a "home" position.

Allowable Subject Matter

10. Claims 1-7 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

11. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not teach nor fairly suggest a method that requires a suction device such as a mechanical pipette, comprising a body comprising an associated end part with an open distal end directed away from the body; a removable disposable tip enclosing a sample space for receiving a liquid sample, wherein said body is for attaching said removable disposable tip; said end part of the suction device further comprising an enclosed cylinder space containing a reciprocatingly movable means, a plunger, for changing the volume of the cylinder space to allow for a sample to

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be received in the tip; and a semi-permeable, removable barrier means attached to the end part; wherein said plunger is adapted to remove the removable tip and the removable barrier means from the end part.

Conclusion


12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cote et al., Li et al., Rainin et al. (20003/0082078 ; 2001/0055547 ; ,841), Smith, Telimaa et al., Cronenberg et al., Wanner, Yarborough et al., Magussen Jr. et al., Kelly et al., Hood, Wainwright et al., Homberg, DeVaughn et al., Hansen et al., Sala et al., and Tervamaki disclose pipetting devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is (703) 305-0399. The examiner can normally be reached on M-F, with 2nd and 4th F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

brg
June 29, 2003


Jill Warden
Supervisory Patent Examiner
Technology Center 1700